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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,268	02/19/2002	Ronald Turfitt	LARUE-8	6966
29106	7590	06/16/2004	EXAMINER	
ROBERT GROOVER III 11330 VALLEYDALE DR. DALLAS, TX 75230			GOODMAN, CHARLES	
			ART UNIT	PAPER NUMBER

3724

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/080,268	TURFITT ET AL.	
	Examiner	Art Unit	
	Charles Goodman	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed March 18, 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 1, 2, and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felde (DE 42 00 420 A1) in view of the Admitted Prior Art (hereinafter referred to as Prior Art - p. 3).

Felde discloses the invention substantially as claimed except for the cubic boron nitride (CBN) tip. It appears that the tip is PCD. Note c. 2, ll. 55-60. However, the Prior Art teaches that PCD and CBN tips are equivalent in the art. Application Specification, p. 3, ll. 17-25. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to substitute the CBN tip as taught by the Prior Art for the PCD of Felde, since both are deemed to be equivalent hard materials for the cutting

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tips in the sawing art, since they both work equally well, and a selection of one or the other would have been an obvious matter of design choice.

Response to Amendment

5. The declaration under 37 CFR 1.132 filed May 25, 2004 is insufficient to overcome the rejection of claims 1, 2, and 4-11 based upon Felde (DE 42 00 420 A1) in view of the Admitted Prior Art (hereinafter referred to as Prior Art - p. 3) as set forth in the last Office action because: the facts presented are not germane to the at issue.

First, it is noted that the declarant is the inventor of the current application. As such, the declarant's opinions or statements of fact may not be given as much consideration as from a disinterested person. An affidavit or a declaration of the Applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, will not be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982 ; *In re McKenna*, 203 F.2d, 97 USPQ 348 (CCPA 1953).

Second, it appears that the declaration merely include(s) statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716. In other words, while it is appreciated that Applicant's CBN tipped saw blade works well in comparison to that of a PCB tipped saw blade, declarant's statements fails to address the issue why it would not be obvious to substitute the CBN tip of the Admitted Prior Art for the PCB tip of Felde.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Response to Arguments

6. Applicant's arguments filed March 18, 2004 have been fully considered but they are not persuasive.

In response to Applicant's basic arguments that the combination would not be obvious because of mainly the ferrous materials that may be chanced upon while cutting and the positive hook angles, these arguments are traversed. First, whether or not the prior art explicitly teaches cutting ferrous materials, e.g. the occasional nail that may be in the board, is not germane to the claims at issue. None of the claims requires any consideration of ferrous materials per se. Moreover, one of ordinary skill in the art of cutting wood via saws inherently expects to occasionally cut into nails especially in situations when the operator is not careful. At the same time, the ordinary artisan also expects that the saw is hardy enough to be able to cut such materials, albeit at the expense of undue wear and tear. In any event, due to the teachings of the Admitted Prior Art, one of ordinary skill in the art would expect, without undue experimentation, that the modified device of Felde would be fully capable of handling the occasional ferrous material in a more efficient manner. Second, the positive hook angle is shown and taught in Felde, Fig. 4. Although, it may seem that the material of the tip is purely PCB, it is obvious to the ordinary artisan from the totality of the reference teachings that Felde's teachings encompass both the positive hook angle and the tip being a two layer tip.

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

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In lieu of mailing, it is encouraged that all formal responses be faxed to (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-1148.

cg

June 14, 2004



Charles Goodman
Primary Examiner
AU 3724

CHARLES GOODMAN
PRIMARY EXAMINER